Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHAITANYA K. NARULA
HUNG-WEN JEN and HAREN S. GANDHI

Appeal No. 1997-1798
Application 08/311,298

ON BRIEF

Before DOWNEY, GARRIS and WARREN, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 3, 5 through 8, and 10 through 14 as amended subsequent to the final rejection.[1] Claims 15 through 18 are also of record and have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b).

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of the appealed claims under 35 U.S.C. § 103 over Abe.[2] It is well

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[1] Amendment of March 25, 1996 (Paper No. 10).
[2] United States Patent 4,865,630, issued Sep. 12, 1989.

settled that in order to establish a *prima facie* case of obviousness, "[b]oth the suggestion and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), citing *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally*, *In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

The examiner has not provided any evidence in the form of patent and non-patent literature or of knowledge generally available to one of ordinary skill in this art to support his position that one of ordinary skill in the art would have modified the porous membranes prepared by a sol-gel method containing a supported precious metal catalyst for reaction and separation of gases as disclosed by Abe (e.g., col. 2, lines 56-58, e.g., col. 3, line 37) by using the catalytic metals specified in appealed claims 1 and 6, stating only that this person would "have desirably chosen any catalytic components depending on the utility of the catalyst" (answer, page 4; see also pages 4-5).

Thus, it is clear that the examiner has improperly indulged in hindsight by relying on appellants' invention in reaching his conclusion that the invention encompassed by the appealed claims would have been obvious to one of ordinary skill in this art in view of Abe. *See Rouffet*, *supra* (the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellants' claimed invention must be explained); *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

The examiner's decision is reversed.

Reversed

MARY F. DOWNEY	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CHARLES F. WARREN	)	
Administrative Patent Judge	)	

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